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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,231	04/14/2006	Atsushi Yabe	4700.P0327US	7188
23474 7590 02/02/2009 FLYNN THIEL BOUTELL & TANIS, P.C. 2026 RAMBLING ROAD KALAMAZOO, MI 49008-1631				
EXAMINER BAREFORD, KATHERINE A				
ART UNIT 1792		PAPER NUMBER		
MAIL DATE 02/02/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 10/576,231	<b>Applicant(s)</b> YABE ET AL.
<b>Examiner</b> Katherine A. Bareford	<b>Art Unit</b> 1792

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 21 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-3 and 5.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Katherine A. Bareford/  
Primary Examiner, Art Unit 1792

Continuation of 11, does NOT place the application in condition for allowance because: (A) the Examiner first notes that there was an obvious typographical error in the final rejection of October 20, 2008. At paragraph 9, the first two lines should have read "Claims 1-3 and 5 are rejected under 35 U.S.C 103(a) as being unpatentable over Japan 03-287779 (hereinafter '779) in view of Verbunt." This is an obvious typographical error that does not affect the finality of the rejection as the body of paragraph 9 clearly provided that Verbunt was used as the secondary reference in the rejection and why '779 would be modified in view of Verbunt. (B) As to applicant's arguments as to the 35 USC 103(a) rejections using Amelio in view of Verbunt and '779 in view of Verbunt, applicant argues that the bath compositions disclosed in Verbunt, Amelio and '779 correspond to various Examples shown in the present application, and none show the unexpectedly beneficial results of using the combination of glyoxylic acid/phosphinic acid reducing agents and nitrogen containing polymer. The Examiner remains of the position that it would have been obvious to replace the exemplary reducing agents of '779 and Amelio with the reducing agent of Verbunt with an expectation of similar results, as simple substitution of one known element for another to obtain predictable results is a well known acceptable rationale for modification. As to the showing by applicant of unexpected benefits, the Examiner addressed in paragraph 14 of the Final Rejection of October 20, 2008 as to why such a showing commensurate in scope with what is claimed has not been made, and that position is maintained. Applicant argues at pages 6-7 of the after final response that as to the Examiner's position in paragraph 14, that as to the use of the same substrate and silane pre-treatment in the Examples, that "A person skilled in the art would understand that the effect presented in the Examples are caused by the three necessary components and the same effects would occur when other similar substrates and pretreatments are applied." As to the use of the same additional ingredients, applicant further argues that "A person skilled in the art would understand that chelating agents, stabilizing agents, and copper sources of similar kinds can be applied without affecting the results caused by the combination of the three elements of the present invention." However, as discussed in MPEP 716.01 (c) (II), "The arguments of counsel cannot take the place of evidence in the record. In re Schulte, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant." Here applicant is arguing unexpected results. Furthermore, as discussed in MPEP 2145(I), "The arguments of counsel cannot take the place of evidence in the record. In re Schulte, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.")" If applicant is arguing what is commonly understood, a showing must be made. In other words, rather than attorney argument, applicant needs to provide an evidentiary showing that one seeing the examples of the present invention would understand that the substrate, pretreatment or other bath materials would not affect the results. Furthermore, applicant has provided arguments that it is not practical to limit the substrate and pretreatment method to the embodiment disclosed in the examples, or to the polymer used (with the specification showing other polymers). The Examiner is not saying that the invention is limited to these materials. What the Examiner is saying is that the unexpected benefits have not been shown for the range of materials claimed. Furthermore, the Examiner notes that '779 teaches the use of hydrazine and Verbunt teaches glyoxylic acid/phosphinic acid as a replacement for hydrazine, and applicant has not shown that the glyoxylic acid/phosphinic acid combination would be unexpectedly better than hydrazine. (C) As to applicant's arguments as to the provisional obviousness type double patenting rejections, the Examiner notes that the claims of 10/576,230 specifically provides the use of the glyoxylic acid/phosphinic acid reducing agent and Amelio has been cited as to the further use of the polymer. One reading Amelio would clearly expect improved results from the addition of the polymer as Amelio teaches that this addition (to solutions with varying possible reducing agents) will provide improved plating rates. The Examiner further notes that the claims of 12/075,745 provide both the glyoxylic acid/phosphinic acid combination and the water soluble nitrogen containing polymer..